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WILLEM F. GADIANO, ESQ.
McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

FLOOD, MICHELE C

ART UNIT PAPER NUMBER

1654

DATE MAILED: 11 19 2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/604,083

Applicant(s)
Bessette

Examiner
Michele Flood

Art Unit
1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 12, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, and 8 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO 948) 19) ☐ Notice of Informal Patent Application (PTO 152)
- 17) ☒ Information Disclosure Statement(s) (PTO 1449) Paper No(s) 5 20) ☐ Other _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 12, 2002 has been entered.

Acknowledgment is made of Applicant's cancellation of Claims 9-11.

Claims 1, 2 and 8 are under examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 and 8 recite the limitation "pesticidal composition" in line 1. The claims lack clear antecedent basis for this limitation.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Morita (N) and Friedman et al. (A).

Applicant claims a composition for the control of mold mites comprising an acceptable carrier and at least one plant essential oil compound selected from the group consisting of phenyl ethyl alcohol and phenyl ethyl propionate, said composition having a pesticidally effective amount of said plant essential oil compound selected on a basis of toxicity against mold mites. Applicant further claims the pesticidal composition of claim 1, wherein the plant essential oil is phenyl ethyl alcohol.

JP 04059703 teaches a miticidal composition comprising carvone, p- methyl acetophenone, 2-phenylethyl alcohol, (iso)thymol, methyl benzoate and/or methyl salicylate in the form of emulsions, dispersions, oil preparations, dusts, tablets or propellants.

It is noted that the reference does not expressly teach that the composition can be used in the manner instantly claimed (i.e., for the control of mold mites), however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art

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composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

Friedman teaches food product compositions comprising effective dose amounts of aromatic alcohols for the control of microbial growth including bacteria, molds and yeasts, and the growth and reproduction of mite infestation, such as that caused by the mold mite, i.e., (*Tyrophagus putrescentiae*). See Column 13, under "EXAMPLE 10". Friedman teaches that the level of aromatic alcohols comprising the composition is from about 0.15 to about 1.0%, or 0.15 to about 1.5%, or 0.75 to about 1.25%, or 0.1 to about 0.75%, or 0.75 to 1% based on the weight of the food and other physiologically parameters (see Column 6, lines 12-33). Aromatic alcohols, such as the claimed phenyl ethyl alcohol, can be used alone as the effective active agent in the compositions taught by Friedman. Friedman also teaches that phenyl ethyl alcohol can be combined with an acceptable carrier, such as a food product. For instance, in Column 9, under "EXAMPLE 2", Friedman teaches a food product composition comprising 2-phenylethanol or phenyl ethyl alcohol. See also "EXAMPLE 4", in Column 10. In Column 14, lines 41-55, Friedman teaches another food product comprising 2-phenylethyl alcohol.

The cited references are deemed to anticipate the claimed subject matter.

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Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by McGovern et al. (B) and JP 85049452 (O).

Applicant's claimed invention of Claim 1 was set forth above. Applicant further claims the pesticidal composition of claim 1, wherein the plant essential oil compound is phenyl ethyl propionate.

McGovern teaches a composition comprising phenyl ethyl propionate and eugenol (an acceptable carrier).

JP 85049452 teaches an insect catching apparatus comprising a bag of resin (an acceptable carrier) and 2-phenyl ethyl propionate.

It is noted that the references do not expressly teach that the compositions can be used in the manner instantly claimed, however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

The cited references are deemed to anticipate the claimed subject matter.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 10 and 16 of copending Application No. 09/604,157. Although the conflicting claims are not identical, they are not patentably distinct from each other because the ingredients comprising the claimed compositions are the same.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is (703) 308-9432. The examiner can normally be reached on Monday through Friday from 7:15 am to 3:45 pm. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196 or the Supervisory Patent Examiner, Brenda Brumback whose telephone number is (703) 306-3220.

Michele C. Flood
MCF

November 18, 2002